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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,472	09/16/2003	Motokazu Kobayashi	03500.017564	9615
5514	7590	12/22/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				LEE, EUGENE
		ART UNIT		PAPER NUMBER
		2815		

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/662,472	KOBAYASHI ET AL.	
	Examiner	Art Unit	
	Eugene Lee	2815	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/14/03.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of Group I, Species V in the reply filed on 10/22/04 is acknowledged. The traversal is on the ground(s) that the various species are closely related and would not require separate fields of search. This is not found persuasive because the application clearly discloses six distinct species as disclosed in the specification.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 6 thru 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/22/04.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 thru 4, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Izuha et al. 6,060,735. Izuha discloses (see, for example, FIG. 3) a thin film dielectric device (piezoelectric element) 3 comprising a dielectric thin film (piezoelectric film) 5, lower electrode 4, and upper electrode 5. In column 4, lines 51-54, Izuha discloses the dielectric thin film comprising (Pb, La)(Zr,Ti) O₃ which is a piezoelectric film and a

perovskite oxide. In column 7, lines 8-13, Izuha discloses the lower electrode comprising a conductive perovskite oxide. In column 5, lines 3-22, Izuha discloses the bottom electrode film and said dielectric film are composed of continuous columnar grains wherein the bottom electrode, dielectric, and top electrode share the columnar grains. The columnar grains are composed of crystal grains a, b, c which grow from each other. In FIG. 4A, Izuha discloses the bottom electrode, dielectric thin film, and lower electrode sharing the columnar grains A (a region where crystals of said lower electrode and/or said upper electrode and crystals of said piezoelectric film are mixed exists between said lower electrode and/or said upper electrode and said piezoelectric film).

Regarding claim 2, see, for example, FIG. 4A, wherein Izuha discloses the columnar grain (mixed region) A which is formed from a perovskite oxide.

Regarding claim 3 and the limitation “sol-gel method”, this is a product-by-process limitation.

Regarding claim 4, see, for example, column 7, lines 1-16, wherein Izuha discloses the lower electrode may comprising SrRuO_3 (M^1RuO_3) and column 4, lines 51-54, wherein Izuha discloses the dielectric thin film comprising $(\text{Pb}, \text{La})(\text{Zr}, \text{Ti})\text{O}_3$.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. 6,824,898 B2 in view of Murai 6,398,349 B1. Suzuki discloses (see, for example, FIG. 1) a perovskite structure (piezoelectric element) comprising a perovskite oxide layer (piezoelectric film) 12, and lower electrode 10. In column 3, lines 16-20, Suzuki discloses the lower electrode comprising SrRuO₃ (perovskite oxide). In FIG. 1(B), Suzuki discloses the bottom perovskite layer sharing Sr with the bottom electrode (a region where crystals of said lower electrode and/or said upper electrode and crystals of said piezoelectric film are mixed exists between said lower electrode and/or said upper electrode and said piezoelectric film). Suzuki does not disclose an upper electrode. However, Murai discloses (see, for example, FIG. 1) a piezoelectric device comprising a lower electrode 403, piezoelectric film 404, and upper electrode 405. In column 5, lines 33-40, Murai disclose the application of voltage between the two electrodes makes it possible to cause an electromechanical transducing action at the piezoelectric film for an ink jet printing head. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have an upper electrode in order to apply voltage between two electrodes making it possible to cause an electromechanical transducing action at the piezoelectric film of an ink jet printing head.

Regarding claim 5, Suzuki does not disclose a pressure chamber, an ink discharge port, a vibrating plate, and ink. However, Murai discloses (see, for example, FIG. 7) an ink jet printing head comprising a pressure chamber 21, nozzle (ink discharge port) 11, diaphragm (vibrating plate) 30, and ink. In column 6, lines 5-44, Murai discloses the pressure chambers are spaces for storing ink and the diaphragm deforms (from the piezoelectric device) to pressure ink to discharge from the nozzle 11. It would have been

obvious to one of ordinary skill in the art at the time of invention to have a pressure chamber, an ink discharge port, a vibrating plate, and ink in order to have the perovskite structure utilized in an electronic device such as an ink jet printing head.

Product-by-Process Limitations

While not objectionable, the Office reminds Applicant that “product by process” limitations in claims drawn to structure are directed to the product, *per se*, no matter how actually made. *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wethheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al.*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product *per se* which must be determined in a “product by process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or *otherwise*. Note that applicant has the burden of proof in such cases, as the above case law makes clear. Thus, no patentable weight will be given to those process steps which do not add structural limitations to the final product.

INFORMATION ON HOW TO CONTACT THE USPTO

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Lee whose telephone number is 571-272-1733. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on 571-272-1664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eugene Lee
December 20, 2004

